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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MATTHEW MARCUS

_____

Appeal 2009-003816
Application 10/716,840
Technology Center 2100

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Decided: March 22, 2010

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Before JEAN R. HOMERE, ST. JOHN COURTENAY III,
and STEPHEN C. SIU, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) (2002) from the
Examiner's rejection of claims 1-34 and 37-40. Claims 35 and 36 are
cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

INVENTION

The invention on appeal relates to testing a node to determine a match with one or more particular criteria in an instance of an XML document. (Spec. 2, ll. 25-28).

ILLUSTRATIVE CLAIM

1.   A method for searching for one or more logical elements in a hierarchical tree structure of an extensible markup language (XML) document conforming to a schema used for XML, comprising:

providing a representation of an XML document instance containing two or more logical elements, wherein at least one logical element is a parent node and at least one logical element is a child node in a hierarchical tree structure describing the representation;

receiving a query for logical elements satisfying an XPath expression;

searching in the hierarchical tree structure only nodes that potentially have child nodes satisfying the XPath expression; and

providing the logical elements satisfying the XPath expression.

PRIOR ART

The Examiner relies upon the following reference as evidence:

Chau   US 2002/0156772 A1   Oct. 24, 2002

THE REJECTION

The Examiner rejected claims 1-34 and 37-40 under 35 U.S.C. § 102(b) as being anticipated by Chau.

ISSUE

Based upon our review of the administrative record, we have determined that the following issue is dispositive in this appeal:

Under § 102, did the Examiner err by finding that Chau discloses or describes "searching in the hierarchical tree structure only nodes that potentially have child nodes satisfying the XPath expression?" (Claim 1).

PRINCIPLES OF LAW

Anticipation under § 102

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)).

> Anticipation of a patent claim requires a finding that the claim
> at issue 'reads on' a prior art reference. In other words, if
> granting patent protection on the disputed claim would allow
> the patentee to exclude the public from practicing the prior art,
> then that claim is anticipated, regardless of whether it also
> covers subject matter not in the prior art.

Atlas Powder Co. v. IRECO, Inc., 190 F.3d 1342, 1346 (Fed. Cir. 1999) (citations omitted).

FINDINGS OF FACT

In our analysis *infra*, we rely on the following findings of fact (FF) that are supported by the record:

The Chau Reference

1.   Chau discloses creating document access definition (DAD) files. A DAD file is a tree structured XML document. (Para. 0127).

2.   Chau discloses that XML document data is stored in an application table, and particular elements are stored in side tables. (Para. 0211).

3.   Chau discloses that the elements stored in the side tables are used to create indices on the side tables. (Para. 0214).

4.   Chau discloses that a document object model (DOM) tree is generated from the DAD. The XML system traverses the DOM tree to generate SQL queries. (Para. 0732).

ANALYSIS

We decide the question of whether the Examiner erred by finding that Chau discloses or describes "searching in the hierarchical tree structure only nodes that potentially have child nodes satisfying the XPath expression."

Appellant contends that the techniques disclosed in Chau: 1) traverse the *entire* tree structure; and 2) the traversal is not to satisfy the XPath expression. (Reply Br. 2-3) (emphasis added).

The Examiner contends that Chau teaches the limitation in question in paragraphs [0335 and 0336]. (Ans. 12-13). In particular, the Examiner contends that Chau discloses a DAD tree structured XML document which is created from extracting XML elements from a document and storing the elements in side tables. The Examiner further contends that every node in the tree structure has potential child nodes. (Ans. 13)

Based on the record before us, we agree with Appellant's arguments for the reasons discussed *infra*.

We find that Chau discloses a document access definition (DAD) which is a tree structured XML document. (FF 1). Chau further discloses that XML document data is stored in an application table and particular elements and attributes are stored in side tables. (FF 2). This is to allow application programmers to create indices on the side tables. (FF 3). The document object model (DOM) tree described in Chau, comprises relational database nodes. However, Chau expressly states that the DOM tree is traversed *to generate SQL queries*. (FF 4).

Therefore, while we agree with the Examiner that all nodes potentially have child nodes, the child nodes in question have to satisfy an XPath expression in order to anticipate claim 1. We agree with Appellant that the system in Chau does not disclose or describe searching the hierarchical tree structure for "only nodes that potentially have child nodes *satisfying the XPath expression*," as recited in independent claims 1 and 20.

Based on the record before us, we find Chau does not disclose or describe "searching in the hierarchical tree structure only nodes that potentially have child nodes satisfying the XPath expression," as recited in independent claims 1 and 20. We note that "absence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.,* 793 F.2d 1565, 1571 (Fed. Cir. 1986). Accordingly, we reverse the Examiner's anticipation rejection of independent claims 1 and 20, and associated dependent claims 2-19, 21- 34, and 37-40 which fall therewith.

CONCLUSION

Based on the findings of facts and analysis above:

The Examiner erred in determining that Chau discloses or describes "searching in the hierarchical tree structure only nodes that potentially have child nodes satisfying the XPath expression."

ORDER

We reverse the Examiner's rejection of claims 1-34 and 37-40 under 35 U.S.C. § 102(b).

<u>REVERSED</u>

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